

Claim 30 – The method for playing the poker game utilizing a standard 52 card playing deck of claim 29 further comprising additionally comparing two diagonal five card groups extending one from a near top corner to a far bottom corner of said five row by five column arrangement of cards and another from a far top corner to a near bottom corner of said five row by five column arrangement of cards to predefined poker rules to determine an additional two hand rankings.

Claim 31 - The method for playing the poker game utilizing a standard 52 card playing deck of claim 30 further comprising receiving a wager from a player for each row, column, or diagonal group of five cards prior to dealing said cards.

Claim 32 - The method for playing the poker game utilizing a standard 52 card playing deck of claim 31 further comprising paying the player according to a pay table as related to said hand rankings and said wager.

REMARKS

The Office Action mailed December 27, 2000 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

Restriction/Election

The Examiner has imposed an election/restriction requirement in this case. Specifically, it is the Examiner's belief that claims 1 through 7 are drawn to a method of playing a card game, classified in Class 273, subclass 292 and claims 8 through 20 are drawn to an apparatus for playing a card game, classified in Class 463, subclass 13.

During a telephone conversation with the Examiner on December 6, 2000, a provisional election with traverse was made to prosecute claims 1 through 7. The Examiner has required that the applicant affirm this provisional election. Thus, undersigned affirms the election with traverse to prosecute claims 1 through 7.

Rejections Under 35 U.S.C. §112

The Examiner had rejected claims 4 through 7 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that there is no antecedent bases in the claims for "payline".

The Examiner is invited to note that claims 4 through 7 have been amended hereinabove to delete the term [payline] and replace it with the phrase said N card arrangements. Therefore, withdrawal of the rejection of claims 4 through 7 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Rejections Under 35 U.S.C. §103

The Examiner had rejected claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over Moody (1998), presumably, U.S. Pat. No. 5,823,873 (the '873 patent). In particular, the Examiner contended that "Moody discloses a method for playing a poker game that include dealing 5 by 5 array of cards (see column 9, lines 18 to 20).

Moody teaches that the player can select none, some or all cards, replace unselected cards and determining poker hand rankings (see column 13 and column 9, lines 20 to 23). Moody lacks specifying that all the five rows should be dealt face up. However, Moody discloses that in version #2I game play all the fifteen cards are dealt face up (see column 9, lines 55 to 68). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also extend the provision of 'face up' display of the three rows (3x5) game to the five rows (5x5) game for a more challenging game play."

While undersigned appreciates that the Examiner has noted that Moody fails to teach five rows of five cards dealt up, the Examiner has taken Moody completely out of context for application to the claims in question. Throughout the '873 patent, Moody makes clear that the game taught is a replication game. That is, only in one hand of several in the Moody patent, are cards held. Thereafter, those SAME cards are replicated in all other hands. Then, the cards not held are replaced. This is made clear shortly after the Examiner's cited sections. For example, column 9, lines 34 to 47 make this quite clear:

A first hand of five cards would initially be dealt to the player. The player would select which of five cards, if any, the player wishes to hold and then replacement cards would be dealt for the discarded cards. The winning or losing outcome of the first hand would then be determined.

For the second hand, the cards held by the player from the first hand would then be redisplayed on the video screen and additional cards would be dealt to complete the player's second hand. Again the winning

or losing outcome of this second hand would be determined. The steps of redisplaying the held cards from the first hand and the dealing of cards to complete the hand would be repeated for each wager made by the player until the total number of hands originally wagered by the player is completed.

Thus, it is clear that Moody only teaches the selection of cards in a first hand and not the selection of any cards in the array of cards. Applicant's claims have been amended to make this distinction clearer. Since Moody does not teach the holding of ANY cards in the array of cards, but only teaches the holding of some of the cards in one hand, which are then replicated into the other hands, undersigned fails to see the application of the Moody reference to Applicant's claims, especially as amended. In fact, Moody specifically teaches away from allowing the player to select cards from other than the first presented hand as discussed above. Undersigned is not surprised that the Examiner can or has found isolated references which have coincidental similarity with aspects of the present invention. That, however, is not the test for patentability. These references, however, require an enabling teaching apart from applicant's own disclosure.

Next the Examiner had rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Moody (1998) in view of Gibson. In essence, the Examiner contends that although Moody does not teach a three card poker game, but does teach a 3x5 game, and because Gibson teaches three card poker, it would have been obvious at the time the invention was made to modify Moody's play by using 3 sets of cards for each of the three rows for playing a three card poker game.

First, undersigned would respectfully refer the Examiner to the above argument which makes quite clear that Moody does not teach the selection of ANY cards in the array of cards, but only those in the first hand dealt, which are then replicated into all other hands. Absent overcoming this fundamental difference between Moody and Applicant's invention, the Moody reference is inappropriate. Beyond that, and focusing on the specific assertion made by the Examiner with respect to Claim 3, undersigned would note also that the Examiner has failed to specify a suggestion in either teaching (Gibson or Moody) to combine the two. Absent such a suggestion to combine, such selective combination is impermissible.

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. §103 which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal, Inc. v. Rudkin-Wiley Corp., 437 F.2d 1044 (Fed. Cir. 1988).

These precedents, which are decisions from the Court of Appeals for the Federal Circuit are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

Next the Examiner had rejected Claims 1, 2, 4, and 5 under 35 U.S.C. §103(a) as being over patentable over Moody (2000), presumably, U.S. Pat. No. 6,098,985 (the '985 patent). The Examiner essentially makes the same argument as made above with respect to the '873 reference. However, again, this new Moody reference, '985, has the same problem as the '873 reference.

That is, contrary to the Examiner's initial assertion, the '985 patent does not teach that "the player can select none, some or all cards", but rather, teaches that "[t]he present invention includes a variety of electronic video poker games each having multiple hands in which the player selects zero, one or more cards from a first hand and the selected cards are duplicated into each of the other hands." (Column 2, lines 49 to 53). To be more explicit, the '985 patent goes on to state that "[t]he player selects which cards he wishes to hold from the lowermost row and these cards are duplicated into all of the other rows on which the player has wagered. Replacement cards are dealt for the unselected cards in the lowermost row and additional cards are provided to complete each five card hand in the other rows." (column 5, lines 29 to 35).

Thus, again, Applicant's claims are not in fact implicated by Moody, especially in light of the amendments which provide further clarity and distance from both Moody references.

Finally, the Examiner had rejected claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over Moody (1998 – '873) in view of Moody (2000 – '985). First, the Examiner asserts that the '873 patent "discloses five vertical column poker hand rankings for pay out in addition to the usual five rows. (see column 10, lines 34 to 41)." Column 10, lines 34 to 41 is a continuing discussion of Moody's Version #2J game. A closer reading of column 10, lines 21 to 41 discloses that even in this variation of the game, held cards from one hand are replicated into the other hands. Thus, ONLY the vertical rows of cards which are NOT HELD are available for this vertical form of the game, because "[e]ach card that the player selects to be held is duplicated into the two face down rows directly below the held cards as well as the two face down rows directly above the held card." This clearly results in each column of held cards being the exact same card. If the held cards could thus be part of the vertical payout scheme as the Examiner intends, then the player would always end up with five of a kind – which would not be a good result for the house. Clearly, Moody teaches only the use of the non-held vertical columns and specifically teaches away from use of ALL vertical columns as pay lines.

The Examiner then while acknowledging that Moody (1998 – '873) does not teach diagonal pay lines, asserts that Moody (2000 – '985) teaches diagonal as well as "W" and "M" shaped pay lines. (no column and line reference cited). However, a closer reading of the '985 patent indicates that the reference to these diagonal, "W", and "M" shaped pay lines have nothing to do with a poker game at all. Instead, Moody is

(inadequately, not to mention not enabling) attempting to describe a variation in the form of a spinning reel slot machine game. See column 10, lines 14 to 41. Moody specifically departs from his poker game description and turns to a reel slot game to attempt to disclose these alternate pay lines. Putting aside the fact that these three paragraphs of description would likely not be found to be enabling by any court since the game would not work as Moody describes it, the fact remains that Moody is teaching away from being able to obtain the pay lines at issue in the poker format of his game. When a cited reference not only fails to teach the element in question, and instead teaches away from it, that reference cannot be deemed applicable. Furthermore, applicant's invention solves a different problem than the references, and such different problem is recited in the claims. In re Wright, 6 U.S.P.Q.2d 1959 (1988).

In addition, there is no teaching or motivation in any of the prior art of record which appreciates the existence of the problem solved by the present invention. Thus, applicants recognition of the problem is, in itself, strong evidence of the nonobviousness of the invention. In re Nomiya, et al., 184 U.S.P.Q. 607, 612 through 613 (CCPA 1975).

Moreover, the fact that those skilled in the art have not implemented the invention, despite its great advantages and a strong incentive to do so indicates that it is not obvious.

The Examiner then asserts that with regard to the progressive aspects of applicant's invention, "it would have been obvious for one having ordinary skill in the art at the time the invention was made to use the progressive disclosures of Moody for playing a more complex game." First, the Examiner fails to cite any progressive disclosures in Moody. Second, as stated above, the Moody game and Applicant's game

are not even comparable. These are two completely different games. Any use of progressives in Moody, has nothing to do with applicant's invention. In fact, it could not have anything to do with applicant's invention, because the Moody game is so different from applicant's game. A player would never be allowed to buy 12 pay lines in the Moody game, because the player would be a guaranteed winner in Moody (just hold all five cards from the first hand and you win all the vertical lines – 5 of a kind every time!).

New Claims

New claim 21 has been included which the Examiner should find clearly allowable. This claim provides sharp contrast over the prior art. While comparable to claim 1 as amended, new claim 21 is written in a slightly different manner which undersigned believes provides patentable contrast as well.

New claims 22 through 28 depend in series from new claim 21 and provide further contrast over the prior art.

New claim 29 has been included which the Examiner should find clearly allowable. This claim also provides sharp contrast over the prior art. This new claim views the invention from the vantage point of, inter alia, a single deck of cards.

New claims 30 through 32 depend in series from new claim 29 and provide further contrast over the prior art.

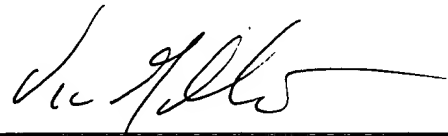
With respect to the other citations that the Examiner had cited to show the state of the art further, general agreement appears to exist with respect to their limited applicability. By further limiting the claims, these citations are even less relevant. Further commentary on these non-applied citations will not be made at this time so as to not further burden the record. Suffice to say, however, that none of these references

when considered singly or in any conceivable combination teach or render obvious the nexus of patentability as defined in the claims now before the Examiner.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: May 21, 2001

Respectfully Submitted:

A handwritten signature in black ink, appearing to read 'Victor J. Gallo', written over a horizontal line.

VICTOR J. GALLO

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